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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/582,580

06/12/2006

Fajun Nan

56816.1740

1738

30734

7590

08/07/2008

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EXAMINER

HAVLIN, ROBERT H

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

08/07/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/582,580

**Applicant(s)**

NAN ET AL.

**Examiner**

ROBERT HAVLIN

**Art Unit**

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 2-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

**Status of the claims:** Claims 1-9 are currently pending.

**Priority:** This application is a 371 of PCT/CN03/01115 (12/25/2003) and claims foreign priority to CHINA 200310109331.0 (12/12/2003).

**Oath:** The signed oath is in a language other than English and must conform to 37 CFR 1.69.

**IDS:** No IDS was filed with this application. Applicant is reminded of the duty to disclose relevant art to this application.

#### *Claim Rejections - 35 USC § 102*

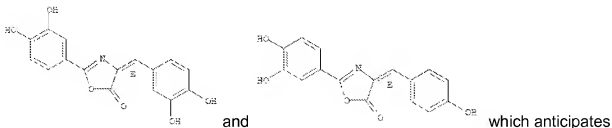
1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Okura et al. (STN abstract of WO 95/06032).

The prior art teaches the compounds:



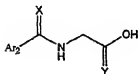
the claims when X is O; Y is O; Ar1 is 4-hydroxyphenyl or 3,4-dihydroxyphenyl; and Ar2 is 3,4-dihydroxyphenyl.

**Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

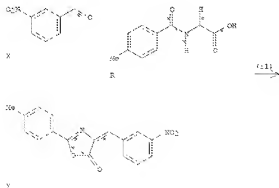
4. Claims 4, 6, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Afifi et al. (Abstract of Revue Roumaine de Chimie (1983), 28(8), 849-55) in view of March (March's Advanced Organic Chemistry, 5<sup>th</sup> ed., (2001) Wiley, 2083 pages). The claims read on forming a compound of claim 1 by condensating (assumed to mean



condensing)

and  $Ar_1CHO$ ,

Afifi et al. teaches the following method of making the related product:



PK(11) P.T. X 84-61-6, R 27115-50-0  
 IRO 6 8652-77-3  
 CAT 127-vp-9 80286

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March teaches methods of making related products and procedures for modifying the substituents on phenyl groups. In addition, March teaches the importance of optimizing solvents and reaction conditions to produce the desired product.

The claimed process is obvious to one of ordinary skill in the art because Afifi et al. teaches the closely related process which differs only by a substituent on the phenyl ring and March teaches how to modify the method to produce the instantly claimed process. Since the teachings of March are well within the technical grasp of one of ordinary skill in the art, it would be obvious to modify the process of Afifi and arrive at the instant invention.

5. Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okura et al. (STN abstract of WO 95/06032) in view of March (March's Advanced Organic Chemistry, 5<sup>th</sup> ed., (2001) Wiley, 2083 pages) and Greene et al. (Protective Groups in Organic Synthesis Greene, 3<sup>rd</sup> ed., New York John Wiley & Sons, Inc., 1999, 779 pages).

Greene et al. teaches on pages 518-22 the numerous methods of using the Boc protecting group to protect groups such as the variable groups of the claim. Page 150 teaches the desirability of using DMAP in a condensation reaction.

March teaches generally the skill level of one of ordinary skill in the art and shows how numerous routes for condensation reactions are known, including the instantly claimed method, generally.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okura et al. (STN abstract of WO 95/06032) in view of Neye et al. (Abstract of Exp Clin Endocrinol Diabetes. 1998;106(4):292-8).

The claim reads on using the compound taught by Okura et al. to treat diabetes.

Okura et al. teaches the compound as a tyrosine kinase inhibitor.

Neye et al. teaches how tyrosine kinase inhibitors affect insulin release.

The claim would be obvious to one of ordinary skill in the art because Neye teaches how the compounds taught by Okura are useful for treating diabetes.

#### ***Specification***

The specification is objected to for containing numerous typographical errors and grammatical problems, for example: the degree symbol is a box throughout and in [0114] the specification reads "the affinities of compounds wang520 and wang516 are little week, ...". Applicant is required to read through the specification and correct all typographical and grammatical errors.

#### ***Specification***

The specification is objected to for containing numerous typographical errors and grammatical problems, for example: the degree symbol is a box throughout and in [0114] the specification reads "the affinities of compounds wang520 and wang516 are little week, ...". Applicant is required to read through the specification and correct all typographical and grammatical errors.

***Claim Objections***

Claims 4, 5, and 7 are objected to for using unknown characters or words such as "condensating" and a box-character. Claims 2-9 are objected to for being dependent on a rejected base claim.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Havlin whose telephone number is (571) 272-9066. The examiner can normally be reached on Mon. - Fri., 7:30am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Joe McKane can be reached at (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert Havlin/  
Robert Havlin, Ph.D.  
Examiner

/Kamal A Saeed, Ph.D./  
Primary Examiner, Art Unit 1626

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